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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,344	01/20/2006	Ian Lawrence	LAWRENCE-1 PCT	2149
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COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576				
EXAMINER				
HOOK, JAMES F				
ART UNIT		PAPER NUMBER		
3754				
MAIL DATE		DELIVERY MODE		
10/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/565,344

**Applicant(s)**

LAWRENCE, IAN

**Examiner**

James F. Hook

**Art Unit**

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-35 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-32 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI-108)  
Paper No(s)/Mail Date 1/20/06: 5/15/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of the species of figure 1 with a membrane on the outside joined by form fitting injection molding both parts, with a gasket on an end section and using an airtight membrane in the reply filed on August 3, 2009 is acknowledged. The traversal is on the ground(s) that the search would be the same. This is not found persuasive because the particulars of the two embodiments are different where one includes a layer that covers the entire outside and the other that only spans the gaps of a spiral slot, where the species would require a different search in that the search required for a spirally corrugated tube is different than one that is segmented by slots, and such would also require a different computer search which would add a burden on the examiner. It is also noted that the number of possible different embodiments formed from the various possible combinations set forth in the claims was far too numerous to cover with a complete search without being a burden. It is also noted that any species that still is dependent from an allowable generic claim can be rejoined.

The requirement is still deemed proper and is therefore made FINAL.

Claims 33 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 3, 2009.

### ***Claim Objections***

Claim 22 is objected to because of the following informalities: it is not in single sentence form where such does not have a period at the end of it. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 22 recites the broad recitation "a pipe for gas and/or fluid", and the claim also recites "in particular with an internal combustion engine" which is the narrower statement of the range/limitation.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 31, it is not clear what the term "cardanically" is suppose to refer to when such term does not appear in the dictionary therefore it is not clear if such is a misspelled word or a term known only to specific fields, however, such should be checked for correctness and if such is correct the examiner requests a definition of what it means so that the record is clear what applicant feels the term means. For sake of speedy prosecution the examiner will treat such as meaning any connected flexible structure similar to that of applicants figures.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 23, 25, 29-31, and 35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Freudenberg (DE 7403631).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-29, 31, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Scarazzo. The reference to Kahn discloses the recited pipe for carrying gas and/or fluid where the use of such with an internal combustion engine is merely intended use where the hose of Kahn is capable of used with a combustion engine in some form, comprising a supporting body 13 formed of a rigid plastic having multiple recesses as seen in the figures which pass through the body and inherently allow such to be flexible yet resist compressive forces during use of the pipe, a thin membrane 22 of various different plastics is integrally molded to the supporting body, the membrane is on the outside, inherently the tube has ends of some sort, the membrane is form fitting, it is considered that the injection molding steps of claim 24 are not limiting to the article claim in that method steps hold no patentable weight on article claims, the recesses are distributed along the pipe such that it can flex in two or more directions inherently, the membrane is in one piece as is the supporting body, such is a suction pipe, since the structure of the supporting body is shaped similarly to applicants it is considered to be cardanically flexible, the supporting body forms ring sections which are seen to be offset and at least some are offset 90 degrees with respect to others, and the membrane is airtight and tightly seals the recesses. The reference to Kahn discloses all of the recited structure with the exception of providing the ends with connection portions which can be formed of a second material and forming an outer gasket of a second material. The reference to Scarazzo discloses that it is old and well known in the art to provide flexible tubes with connections at the ends

to connect to other things where an insert of a second material can be used and formed in such a way that the material forms a gasket outside of the membrane at 22 as well. It would have been obvious to one skilled in the art to modify Kahn by providing an insert of a second material in end connection sections of the tube and to provide such with an outer gasket of second material as suggested by Scarazzo where such would allow for the tube to be connected to a suction source and more positively seal the connection thereby insuring proper functioning of the hose.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Scarazzo as applied to claims 22-29, 31, 32, and 35 above, and further in view of Yamamura. The reference to Kahn as modified discloses all of the recited structure with the exception of using the hose for suction in an engine. The reference to Yamamura discloses that it is old and well known in the art to use corrugated hoses with connection ends for suction lines and that such can be attached to an engine. It would have been obvious to one skilled in the art to modify Kahn as modified to be capable of use with a combustion engine as suggested by Yamamura where such would improve the usefulness of the tube when such is a known tube for use with suction.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Coel, Hinsky, Stumpp, Andorf, Lefere, Nobileau and Balazs disclosing state of the art hoses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/  
Primary Examiner, Art Unit 3754

JFH